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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/911,588 08/14/97 MALIN S IMET0002

MM12/1026

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EXAMINER

MILLER, C

ART UNIT

PAPER NUMBER

2857

DATE MAILED:

10/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/911,588

Applicant(s)

Malin et al.

Examiner

Craig Steven M. H.

Group Art Unit

2857

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 28 July 1995
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-47 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-35 is/are allowed.
- ☒ Claim(s) 36-47 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other formal claims now required

Office Action Summary

1. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title."

2. Claim 36 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory matter. The Examiner notes In re Sarkar, 200 USPQ 132 (CCPA 1978).

It is readily apparent that when claim 36 is taken as a whole, the claim is directed to the preemption of a mathematical algorithm, and is thus non-statutory. The examiner notes while applicant specifies that the data is stored in a memory, because the claim is directed to a data set, the reference to a processor and a memory is deemed merely as defining the field of use and as such are not specifically claimed structure (as would be the case in an apparatus claim setting forth the apparatus used to generate such a data set).

Furthermore the Examiner notes that while the disclosed invention has a practical application in the technological arts, the claimed invention is directed to mere data and is therefor deemed non-statutory.

The Examiner notes that the Applicant may ensure a § 101 "safe harbor" by claiming the data sets as the result of operation of computing means within an apparatus claim, by claiming a data set as being the end result of a computer program product or by including the claimed data set as the result of a computer implemented method, and thus ensuring the withdrawal of any § 101 rejection, staying within the limitation of the teachings of the specification, of course.

With respect to dependent claims 37, 39, 40, 42 and 45-47, no § 101 rejection for said claims is included because of the problems under § 112, second paragraph listed below. The Examiner does note that the claims appear to be drawn to an apparatus which are generally held to be statutory.

3. Claims 37-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Said claims are purported to be directed to apparatus, but they depend from a claim directed to a data structure, therefore it is not possible to determine the metes and bounds of said claims. If applicant intends to claim an apparatus, the base claim should be modified to more clearly define the intended field of the invention. Because of the extent of the clarity problems of said claims, no statement with regard to their patentability could be made. Applicant's attention is however directed to paragraph 5 below.

4. Claims 1-35 are allowable over the prior art of record.
5. The Examiner notes that while the use of system modeling embodied in calibration sets is known in general, the prior art of record neither disclose nor suggest the use of basis sets within such modeling as defined within the specification (see pages 9 and 10).
6. Applicant's arguments of paper #8 have been fully considered but they are not deemed persuasive in view of the new grounds of rejection.

The arguments directed towards the § 101 rejection are disagreed with. Data sets, though usable within computer implemented methods, are not programs and are deemed mere data and as such fall outside that deemed statutory within the binding case law.

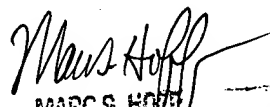
The requirement for a program listing is withdrawn.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Craig Steven Miller whose telephone number is (703) 305-9730. Art Unit facsimile services are now available at (703) 308-7722.

The Examiner can normally be reached on Mondays-Friday from 07:30am-4:00pm EST. Should repeated attempts to reach the Examiner be unsuccessful, the Examiner's Supervisor, Marc Hoff may be reached at (703) 308-1677.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Craig Steven Miller (ss)
18 October, 1999


MARC S. HOFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800